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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/361,829	07/27/1999	ELLEN M. HEATH	1074.003US1	6019

27073 7590 10/30/2002

LEFFERT JAY & POLGLAZE, P.A.
P.O. BOX 581009
MINNEAPOLIS, MN 55458-1009

EXAMINER
ALLEN, MARIANNE P

ART UNIT	PAPER NUMBER
1631	

DATE MAILED: 10/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/361,829	Applicant(s) HEATH ET AL.	
	Examiner Marianne P. Allen	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sh et with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *9/16/02* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) *20-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Applicant's arguments filed 9/16/02 have been fully considered but they are not persuasive.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

This application contains claims 20-22 drawn to an invention nonelected without traverse in Paper No. 6. Applicant is requested to cancel the non-elected claims.

Claims 1-19 are under consideration by the examiner.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 6, 8, 14, and 16-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-9, 23-25, 30-31, and 34-40 of copending Application No. 09/255,146. Although the conflicting claims are not

identical, they are not patentably distinct from each other because the '146 set of claims encompasses the computer systems, computer readable media, and modules of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

Claims 1-5, 7, 9-13 and 15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

This rejection is maintained for reasons of record. The specification distinguishes between aspirating to remove liquid and mixing by a cycle of aspirating and dispensing fluid in and out of a pipette. The specification discloses these steps in different terms. No portion of the specification discusses the step of removing liquid by aspiration with respect to gentle or vigorous rates. Note that the mixing disclosure does not result in a net loss of liquid. The liquid is aspirated and then dispensed. The specification does not support the concept presently in the claims. Applicant could amend the claims such that the "mixing a sample" step recited that the mixing was performed by aspirating and dispensing fluid at levels from gentle to vigorous. Alternatively, applicant could amend the claims such that the "aspirating a sample" step recited that the aspiration "may be accomplished at different rates."

Claim Rejections - 35 USC § 102

Claims 6, 8, 14 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Petschek et al. (U.S. Patent No. 5,389,339).

This rejection is maintained for reasons of record.

Applicant has failed to point out those limitations of the claims that are not disclosed by Petschek et al. Applicant has not explained why the claims do not encompass the device of Petshek et al. Whatever "complex functions" applicant is alluding to are not limitations of these claims. Petschek's device is interfaced with a graphical user interface and the claims have no limitation to being programmable beyond that disclosed by Petschek et al.

Claim Rejections - 35 USC § 103

Claims 1-9, 10, 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petschek et al. (U.S. Patent No. 5,389,339) in view of Lange (U.S. Patent No. 6,232,464).

This rejection is maintained for reasons of record and in view of the above remarks.

Claims 9, 11, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petschek et al. (U.S. Patent No. 5,389,339) in view of Lange (U.S. Patent No. 6,232,464) and further in view of Johnson et al. (U.S. Patent No. 5,584,039).

This rejection is maintained for reasons of record and in view of the above remarks.

Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petschek et al. (U.S. Patent No. 5,389,339) in view of Lange (U.S. Patent No. 6,232,464) and further in view of Poulter et al. (U.S. Patent No. 6,072,795).

This rejection is maintained for reasons of record and in view of the above remarks.

Claims 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petschek et al. (U.S. Patent No. 5,389,339) in view of Lange (U.S. Patent No. 6,232,464) and further in view of McNutt (U.S. Patent No. 5,802,389).

This rejection is maintained for reasons of record and in view of the above remarks.

With respect to all of these rejections, applicant's arguments concerning the integral device of Petschek et al. are not understood in view of the disclosure on page 3 that the invention contemplates robotic workstations, stand-alone apparatus and the like which could also be integral devices. The intent of the invention appears to be minimizing human interaction with the samples which such integral devices accomplishes. While applicant may have specifically contemplated something different from Petschek et al., the claims do not preclude the invention of Petschek et al. and obvious variations thereof. "Computer" and "computer readable medium" and "computer system" encompass all manner of electronic devices and the software that governs their actions. Note that Figure 1A (for example) of Petschek et al. discloses a computer with programmable memory driving the various assemblies. The computer, computer system, and software can be modified in all of the usual ways known to those of ordinary skill in the art.

Conclusion

No claim is allowed.

This action has been made non-final in view of the inadvertent omission of the double patenting rejection in the prior Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 703-308-0666. The examiner can normally be reached on Monday-Friday, 7:00 am - 1:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Marianne P. Allen
Primary Examiner
Art Unit 1631

mpa
October 25, 2002